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Attorneys for Apple Inc.

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA

IPCOM GMBH & CO. KG,

Plaintiff,

vs.

APPLE INC.,

Defendant.

Case No. 5:14-MC-80037-EJD (PSG)

**THIRD DECLARATION OF
WOLRAD PRINZ ZU WALDECK
UND PYRMONT IN SUPPORT OF
APPLE INC.'S MOTION TO
QUASH SUBPOENA IN A CIVIL
CASE**

1 I, Wolrad Prinz zu Waldeck und Pyrmont, declare as follows:

2 1. I am an attorney with Freshfields Bruckhaus Deringer LLP, counsel to Apple Inc.
3 (“Apple”). I have been licensed to practice law in Germany since 2003.

4 2. I am familiar with the facts set forth in this declaration from personal knowledge and
5 documents I have reviewed.

6 3. I have submitted a declaration in support of Apple’s Motion To Quash Subpoena In A
7 Civil Case dated May 2, 2014 (hereinafter: “First Waldeck Declaration”), and a second declaration
8 in support of Apple’s Reply in support of its Motion To Quash Subpoena In A Civil Case
9 (hereinafter “Waldeck Reply Declaration”). Herewith, I submit a third declaration in support of
10 Apple’s Reply in support of its Motion To Quash Subpoena In A Civil Case.

11 4. On July 9, 2014, the Karlsruhe Court of Appeal announced its decision in the related
12 *IPCom v. Nokia* proceedings (file no. 6 U 29/11) (see Waldeck Reply Declaration ¶¶ 13-18),
13 involving IPCom’s EP 268 patent, which IPCom sometimes refers to as the “#100a Patent.”
14 Attached as Exhibit H is a copy of the judgment. An English translation thereof is being prepared
15 and will be submitted as soon as it is complete.

16 5. In the district court proceedings in the *Nokia* case, the Mannheim Court issued its
17 judgment on February 18, 2011 (file no. 7 O 100/10), finding Nokia to infringe the patent as
18 originally granted. However, in the course of subsequent opposition (i.e., patent invalidity)
19 proceedings against the EP 268, the Technical Boards of Appeal of the European Patent Office
20 significantly restricted the scope of the claims of the EP 268 patent—as set out in the Boards of
21 Appeals decision of March 7, 2013 (file no. T 1282/12). The Boards of Appeal found the patent
22 partially invalid due to an inadmissible extension of subject matter, restricted the scope of the
23 remaining claims, and remanded the restricted patent to the Opposition Division of the European
24 Patent Office for further review of the substantive requirements of patentability. These proceedings
25 are ongoing. The restrictions imposed by the European Patent Office are already final limitations of
26 the EP 268 patent; the ongoing opposition proceedings against the patent based on the Technical
27 Boards of Appeal’s remand can only result in a further restriction of the patent or its complete
28 invalidation.

1 6. In its decision of July 9, 2014, the Karlsruhe Court of Appeal court vacated the
2 judgment below and dismissed ICom's complaint, holding that the EP 268 Patent as restricted by
3 the European Patent Office is not standard essential, and that Nokia did not infringe either literally or
4 under the doctrine of equivalents.

5 7. As stated in my earlier Reply Declaration (at ¶ 17), the Court of Appeal's *Nokia*
6 decision will not formally bind the outcome of the Court of Appeals *ICom v. Apple* proceedings
7 regarding the EP 268 patent. Nevertheless, ICom's EP 268 patent infringement allegations against
8 Apple were based on the same sections of the UMTS standard on which ICom relied for its EP 268
9 patent infringement allegations against Nokia, and thus the Court of Appeal's *Nokia* decision likely
10 indicates the *Apple* outcome for those same EP 268 patent allegations. Although the appellate court
11 could theoretically issue a diverging decision in *ICom v. Apple*, I believe this would be extremely
12 unlikely.

13 8. The Karlsruhe Court of Appeal gave ICom leave to pursue a further appeal on points
14 of law to the Federal Supreme Court. Such further appeal proceeding, if initiated, would be
15 expected to take between 18 and 24 months—and will likely be decided only after the Karlsruhe
16 Court of Appeal concludes the *ICom v. Apple* appeal proceedings.

17 9. Given that the *Nokia* decision is a strong indicator that Karlsruhe Court of Appeals
18 will affirm the district court's adverse judgment against ICom in the *Apple* case, the *Nokia* decision
19 only strengthens my previously expressed belief that it would be very unlikely that the Karlsruhe
20 Court of Appeal would address damages on appeal. Damages will be a moot point if the adverse
21 merits judgment against ICom is affirmed, and in the unlikely event that the Court of Appeals
22 reverses on the merits, I believe it would remand the case to the Mannheim District Court to address
23 damages in the first instance.

24 10. For these reasons, the new *Nokia* decision underscores that ICom has no present
25 need for Apple's confidential license information.

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1 I declare under penalty of perjury under the laws of the United States that the foregoing is
2 true and correct.

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4 Dated: July 14, 2014



5 Wolrad Prinz zu Waldeck und Pyrmont
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